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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,047	10/29/2003	Michael A. Della Vecchia	P1145/20005	5839

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EXAMINER

SCHWARTZ, JORDAN MARC

ART UNIT	PAPER NUMBER
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2873

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/30/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/696,047

Applicant(s)

DELLA VECCHIA ET AL.

Examiner

Jordan M. Schwartz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Claim Objections***

Claim 1 (and its respective dependent claims 2-28) is objected to for the following reason. Since the intended meaning could be determined from the specification and the Figures, a 112 rejection was not made but instead this lack of clarity issue is being raised in the following claim objection.

Specifically, that part of the claim stating “performing said medical procedure on said eye in accordance with said iris biometric image” creates a lack of clarity. Specifically, the biometric image does not state what procedure to perform but instead provides information (such as detecting a tumor) from which it is then determined what procedure to perform. For purposes of examination the assumed meaning is “performing said medical procedure on said eye in accordance with information provided by said iris biometric image”.

Claim Rejections - 35 USC § 112

Claim 28 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, the claimed “wherein said feature” lacks an antecedent basis and it is not clear if the dependency of the claim is incorrect (and if so, what claim, claim 28 was meant to depend from) or if some additional limitations were inadvertently omitted and the lack of clarity renders the claim vague and indefinite. For purposes of examination, it is assumed that claim 28 meant to depend from claim 18.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Hohla et al patent number 7,146,983.

Hohla reads on these claims by disclosing the limitations therein including the following: a method for performing a medical procedure (Figure 1, column 10, line 25 to column 11, line 17) comprising obtaining an iris biometric image representative of an iris of an eye (column 10, lines 5-24, column 10, lines 58-61, column 11, line 9); and performing a medical procedure on an eye based upon the information provided by the biometric image (column 10, line 25 to column 11, line 17, column 12, lines 19-44). Hohla further discloses obtaining first and second biometric images and comparing them to provide a biometric comparison result (column 12, lines 19-44, column 16, lines 63-67); identifying an eye or iris in accordance with the result (column 10, line 57 to column 11, line 17); the eye having at least one feature which is represented by at least one biometric image

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(column 11, lines 25-45, column 11, line 35, claim 11); performing the medical procedure in accordance with the identifying (Figure 1, column 10, line 25 to column 12, line 44); determining a location, orientation, translation or altering a relative location of the iris in accordance with the at least one feature (column 2, lines 38-45, column 10, line 57 to column 11, line 17); directing a light beam in accordance with the at least one feature (column 5, lines 26-51); providing an optimized image in accordance with an image quality metric and to emphasize a visualization of a selected feature (column 10, line 58 to column 11, line 24, column 13, lines 27-38); performing a comparison of the images for identifying a person within a security verification (column 10, line 58 to column 11, line 24, column 13, lines 27-38); performing a surgical procedure (column 10, line 25 to column 11, line 17); locating a tumor (column 11, line 31); performing a diagnostic of an eye (column 10, line 36); superimposing light beams to provide a composite image (column 16, line 64); and correcting an aberration (column 19, line 27). The claimed "performing an optical biopsy", "measuring the size of a feature within the eye such as a tumor or lesion" would be inherent in the method of Hohla depending upon what information was disclosed by the biometric image. Specifically, if a medical diagnostic discloses some adverse condition of the eye that requires a medical procedure then inherently the medical procedure will be performed based upon this information provided by the biometric image. For example, if the diagnostic discloses a tumor or lesion, then inherently its size would be determined.

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Claims 1-20, and 23-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Wilkes et al patent number 5,751,836.

Wilkes reads on these claims by disclosing the limitations therein including the following: a method for performing a medical procedure (column 1, lines 35-45) comprising obtaining an iris biometric image representative of an iris of an eye (abstract, column 1, lines 35-45, column 3, lines 10-40); and providing a medical diagnostic of an eye i.e. "performing a medical procedure" based upon the biometric image (column 1, line 42-45). Furthermore, the method disclosed by Wilkes will inherently perform a medical procedure on an eye based upon the information provided by the biometric image this being reasonably based upon Wilkes disclosing that the biometric imaging can be used to provide a medical diagnostic of an eye (column 1, lines 35-45). Specifically, if the medical diagnostic discloses some adverse condition of the eye that requires a medical procedure then inherently the medical procedure will be performed based upon this information provided by the biometric image. Wilkes further discloses obtaining first and second biometric images and comparing them to provide a biometric comparison result (column 1, lines 35-45, column 3, lines 10-31); identifying an eye or iris in accordance with a biometric comparison result (column 2, lines 30-62, column 4, lines 51-62); the eye having at least one feature which is represented by at least one biometric image (column 2, lines 30-35, in which the "feature" could be the "limbic boundary of the iris", the "boundaries of the eyelids" or whatever is detected by the diagnostic); determining a location of the iris in accordance with the at least one feature

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(column 7, line 65 to column 8, line 67). The procedure of Wilkes will inherently require determining orientation and translation of the iris this being reasonably based upon Wilkes discloses sequentially locating various features of the iris and pattern matching the image to a stored image from a database (column 7, line 65 to column 9, line 38) and Wilkes disclosing a mapping function constrained to be a similarity transformation i.e. translation, shift, scale and rotation (column 9, line 62). Wilkes further discloses altering a relative location of the iris (column 4, lines 6-10 re an alignment mechanism for the purpose of permitting the user to self-position the eye); directing a light beam in accordance with the at least one feature (column 3, lines 41-44); providing an optimized image in accordance with an image quality metric and to emphasize a visualization of a selected feature (column 7, lines 5-14, re acquiring a sequence of images until one with the required quality of obtained); performing a comparison of the images for identifying a person within a security verification (column 2, line 42, column 4, lines 51-62). The claimed "performing a surgical procedure", "performing an optical biopsy", "measuring the size of a feature within the eye such as a tumor or lesion", "correcting an aberration" would all be inherent in the method of Wilkes depending upon what information was disclosed by the biometric image.

Specifically, if the medical diagnostic discloses some adverse condition of the eye that requires a medical procedure then inherently the medical procedure will be performed based upon this information provided by the biometric image. For example, if the diagnostic discloses a tumor or lesion, then inherently its size would be determined.

Prior Art Citations

Sadkhin patent number 6,425,860, Watson et al publication number 2002/0097375, and Helbing et al patent number 6,735,328 would all read on or make obvious a number of the above rejected claims, however, such rejections would have been repetitive.

For applicant's information, based upon the broadness of some of the claims, particularly claim 1, numerous references would have at least read on this claim. Specifically, there are known retinal scanning systems used to identify either the correct eye (right or left) or the correct patient prior to surgery so that the surgery is performed on the proper eye or patient i.e. "performing the medical procedure in accordance with information provided by said iris biometric image".

Response to Arguments

Applicant's arguments filed August 3, 2006 have been considered with respect to the Wilkes et al reference but they are not persuasive.

Specifically, applicant argues that Wilkes does not disclose performing a medical procedure on an eye. However, Wilkes discloses performing a medical diagnostic which can be considered as a "medical procedure". Furthermore, the method disclosed by Wilkes will inherently perform a medical procedure on an eye based upon the information provided by the biometric imaging. Specifically, Wilkes discloses that the biometric imaging can be used to provide a medical diagnostic of an eye and, as stated in the rejection above, if the medical diagnostic discloses some adverse condition of the eye that requires a medical

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procedure then inherently the medical procedure will be performed based upon this provided information.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is (571) 272-2337. The examiner can normally be reached on Monday to Friday (8:30 to 4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Mack can be reached at (571) 272-2333. The fax

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phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'J. Schwartz', is positioned above the printed name.

Jordan M. Schwartz
Primary Examiner
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January 17, 2007